



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/762,177 | 01/21/2004 | Loretta E. Allen | 84196DF-P | 4773 |

7590 07/07/2005

Pamela R. Crocker
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

FUREMAN, JARED

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2876

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,177

Applicant(s)

ALLEN ET AL.

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the amendment, on 6/21/2005, which has been entered in the file. It is acknowledged that this application is a divisional of application serial number 10/310,519. The parent application has been reviewed, and it is noted that a restriction requirement was made in the parent application, thus precluding a double patenting rejection over related application serial numbers 10/761,671 and 10/762,169. Claims 1-3 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Swan (US 4,832,373, previously cited).

Swan teaches a method for providing indicia on a media, comprising the steps of:

a) forming a first machine-readable indicia (indicia 32, and time of day, see figure 4 and column 2, line 50, which can be considered machine-readable in that text can be read by optical character recognition techniques) on an image layer on a media (page 30, see figure 4 and column 2, line 50); and

b) forming a second machine-readable indicia (indicia 12, 14 and 16, see figure 3 and column 2, lines 35-40 and 46-52, which can be considered machine-readable in that text can be read by optical character recognition techniques) on a protective

Art Unit: 2876

substantially transparent overlayer (transparent sheet 10 is designed to overlay page 30, thereby providing a protective substantially transparent overlayer, see figures 1, 4, and column 2, lines 30-52) on said media (page 30), said second indicia being identical in content to and in registration with said first machine-readable indicia (as shown in figure 4, the indicia 12, 14 and 16 is identical in content to and in registration with corresponding indicia on the page 30. Also see column 2, lines 46-52).

Allowable Subject Matter

3. Claims 1 and 2 have been allowed over the prior art of record.
4. The following is an examiner's statement of reasons for allowance:
5. Applicant's arguments, see pages 5-6, filed 6/21/2005, with respect to Gregory et al failing to teach a second machine readable indicia, identical in content to and in register with said first machine readable indicia, have been fully considered and are persuasive. The 103(a) of claims 1 and 2 have been withdrawn.

Furthermore, as discussed above (see paragraph 2), Swan teaches second machine-readable indicia, identical in content to and in register with first machine-readable indicia. However, Swan fails to teach or suggest forming the second machine readable indicia in the transparent overlayer so as to allow said first machine readable indicia to be read through said protective overlayer (as recited in claim 1), or reading the physical topography of said second indicia on said overlayer and said first indicia on said media by a machine so as to obtain information encoded therein (as recited in claim 2). Since the second indicia 12, 14 and 16, as taught by Swan, is identical to the first indicia 32 (on page 30), Swan does not teach or suggest reading the first indicia

through the transparent overlayer (there is no need to read the first indicia when the second indicia, overlaying the first indicia, provides the same information).

Therefore, without the benefit of applicant's teachings, there is no motivation for one of ordinary skill in the art at the time of the invention to combine the prior art of record in a manner so as to create the invention set forth in claims 1 and 2.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments


6. Applicant's arguments with respect to claim 3 have been considered but are moot in view of the new ground(s) of rejection. As discussed in paragraph 2 above, Swan teaches the invention set forth in claim 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jared J. Fureman
Examiner
Art Unit 2876

June 28, 2005